UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/536,861	03/27/2000	Tibor Juhasz	11236.11MKH	3826

7590 06/24/2002

JAYNE C. PIANA
FULBRIGHT & JAWORSKI L.L.P.
1301 MCKINNEY
SUITE 5100
HOUSTON, TX 77010-3095

EXAMINER	
SHAY, DAVID M	
ART UNIT	PAPER NUMBER
3739	

DATE MAILED: 06/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/536,861	Juhasz et al
Examiner	Group Art Unit
[illegible]	3739

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☑ Responsive to communication(s) filed on _____.

☑ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☑ Claim(s) 12-38 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☑ Claim(s) 12-38 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☑ Information Disclosure Statement(s), PTO-1449, Paper No(s). 12

☐ Interview Summary, PTO-413

☑ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 12, 13, 15-17, 22-28, 31, 34-36, and 38 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Ito et al.

4. Claims 12-20 and 22-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bille et al in combination with Ito et al . Bille et al teach a method such as claimed except for the specific recitation of forming a flap, a tab, the various surface shapes and the creation of an oval flap. Ito et al teach creating the flap by cutting from the photoaltered layer outward to the surface. It would have been obvious to the artisan of ordinary skill to create the flap in the method of Bille et al, since this would enable to removal of a volume of without the time intensive process, and expending of extreemly expensive laser resources that would be requied to eradicate the volume via

a point by albation at every location within the volume or alternatively to employ the method of Bille et al in the method of Ito et al, since this would provide a very accurate removal of tissue in a procedure where accuracy is extremely important, as taught by Bille et al; it would have been further obvious to employ an excimer laser, official notice of which is hereby taken; to configure the surface as claimed, since these various configuration are notorious in the art, official notice of which is hereby taken and to create in oval flap or a flap with a tab, since both these configuration are notorious in the art, official notice of which is hereby taken, thus producing a method such as claimed.

5. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bille et al in combination with Ito et al as applied to claims 12-20 and 22-38 above, and further in view of Bronstein. Bronstein teaches forming an interlocking feature, which can take the form of a tab to affix an implant to cornea. It would have been obvious to the artisan of ordinary skill to form structure as taught by Bronstein on the flap of Warner et al, since this would help afix the flap in place during healing, thus producing a method such as claimed.

This is a provisional obviousness-type double patenting rejection.

6. Claims 12-20 and 22-38 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 5, 7, 8, 10-13 and 15 of U.S. Patent No. 6,110,166 in view of Ito et al. The teachings of Ito et al and the orfficially noticed facts are as set forth above. Thus it would have been obvious to the artisan of ordinary skill to combine these old and well known teachings to producd a method such as claimed above. Thus it would have been obvious to the

artisan of ordinary skill to combine the old and well known teachings to produce a method such as claimed..

7. Claims 21 and 22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 6, 9, and 14 of U.S. Patent No. 6,110,166 in view of Ito et al and Bronstein. The teachings of Ito eta l and Bronstein and the officially noticed facts are as set forth above. Thus it would have been obvious to the combine these old and well known teachings to produce a method such as claimed..

8. Applicant's arguments with respect to claims 12-38 have been considered but are moot in view of the new ground(s) of rejection.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to David Shay at telephone number (703) 308-2215.

David Shay:bhw

June 7, 2002

DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330